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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,986	08/07/2003	Jay S. Walker	01-052	1612

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EXAMINER	
DEODHAR, OMKAR A	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
11/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/635,986	WALKER ET AL.	
	Examiner	Art Unit	
	OMKAR A. DEODHAR	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *24-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/2/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Non-Final Rejection

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 3/2/2009 has been considered.

Election/Restriction

Applicant's election with traverse of claims 1-23 in the reply filed on 7/6/2009 is acknowledged. The traversal is on the grounds that there is insufficient examination burden. This is not found persuasive because, after further search, relevant prior art was discovered and hence, search burden exists. Consequently, the requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

As explained above, after further consideration, relevant prior art surfaced. Accordingly, prior indicated allowability is withdrawn & Applicant's arguments are moot.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, 13, 14 & 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagiwara (US 4,805,907).

Claims 1, 13, 18: Hagiwara discloses a method comprising determining data representative of a wager amount (Figure 2, 18a) and initiating automated play of at least one slot machine (Figure 1, main machine 1 discloses automated play. See Col. 2. Lines 11-15), in which at least one of the at least one slot machine is not available for manual play at least during the automated play (Figure 1, main machine 1 is not available for manual play during its automated play. Only subordinate machines {2a} are played manually); terminating the automated play of the slot machine based on the data (a wager on the subordinate machine provides the player one automated play session in which reels on the main machine are spun.

The session is terminated when the reels stop spinning); receiving a first signal including a representation of the automated play (Figure 1, distributor 5 receives a first signal from main machine 1. See also Col. 1. Lines 60-67); receiving a request from a remote player to view the representation of the automated play (the player's wager is interpreted as a request to view the representation of the automated play); and transmitting a second signal including the representation of the automated play to a remote player (the distributor {5}, via cables {3}, transmits a signal including the automated play representation to a subordinate machine {2a). A CRT monitor on the subordinate machine displays the automated play results).

Claims 2-4: Hagiwara discloses transmitting locking data to the at least one slot machine. (The main machine 1 is locked during automated play. It cannot be wagered on by any player. It is neither operable for manual play nor accessible by any player. Players only access subordinate machines 2a-2b.)

Claim 5: Hagiwara discloses enabling manual play of at least one of the at least one slot machine after terminating automated play. (At conclusion of the automated play session, main machine 1 can be played again, via wagering on subordinate machine 2a.)

Claim 8: Hagiwara discloses determining a communication device that is associated with the remote player and transmitting the second signal to the communication device. (The subordinate machine is a communication device that receives the signals indicating automated play from the main machine).

Claim 14: Hagiwara discloses that the first signal is a video signal. (See Figure 1, optical fibers 4a-4c for transmitting the video data to subordinate machines).

Claims 19, 20: Hagiwara discloses at least one of the at least one slot machine comprises a machine identifier. (The main machine is identified as the device providing automated play. It is a master device with respect to each subordinate machine. Each player at a subordinate machine recognizes that they are wagering on the automated session of the master device. As such, they identify the master machine)

Claims 21, 22: Hagiwara discloses that at least one of the at least one slot machine comprises an indicator of activity in the form of a source of light. (The main machine CRT emits light.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiwara (US 4,805,907) in view of Orr (US 5,909,357).

Claim 6: Hagiwara discloses the invention substantially as claimed but does not disclose stacking one slot machine on top of another slot machine.Orr teaches that vertically stacked devices take up minimal space. (See Orr Col. 2. Lines 34-37). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to stack machines on top of each other, as taught by Orr, for the purpose of saving space. This modification would work just as one would expect it to & yields highly predictable results.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiwara (US 4,805,907) in view of McKay (US 5,813,914).

Claim 7: Hagiwara discloses the invention substantially as claimed but does not disclose that one slot machine's casing may be replaced with a second casing. In a related invention, McKay teaches a slot machine assembly comprising a number of

parts including a slot machine casing. (See McKay, Fig. 1. cabinet 20). Manufacturing said machine requires providing a cabinet. A cabinet is a casing. Thus, McKay suggests that persons of ordinary skill in the art provide cabinets on machines as needed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide replaceable casings, as taught by McKay, in Hagiwara's system. This yields predictable results.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiwara (US 4,805,907) in view of Von Kohorn (US 5,697,844).

Claims 9-12: Hagiwara discloses the invention substantially as claimed but does not teach that the communication device associated with the remote player is: 1) a handheld device; 2) a phone; 3) associated with an IP address or 4) receives the second signal wirelessly.

In a related remote play invention, Von Kohorn teaches a remote gaming system used in a casino. (Col. 113. Lines 50-53). Hand-held devices (Col. 16. Lines 7-10), telephones (Col. 3. Lines 60-62), wireless communication (Figure 1) & communication associated with an IP address (the internet, Col. 162. Lines 58-60).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide a communication device associated with Hagiwara's remote player, in the form of: 1) a handheld device; 2) a phone; 3) associated with an IP address or 4) wireless communication, as taught by Von Kohorn. Providing such devices would work just as one would expect them to & permit remote play. Changes to

the prior art utilziing known elements yielding predictable results are considered obvious.

Claims 15-17 & 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiwara (US 4,805,907) in view of Marnell (US 5,259,613).

Claims 15-17 & 23: Hagiwara discloses the invention substantially as claimed, as discussed above, but does not teach receiving the first signal from a camera viewing the automated play, wherein the camera is controlled by a player.

In a related remote play invention, Marnell teaches transmitting a play session to a remote player using a video camera. (See Marnell Col. 3. Lines 30-41). Players request game operators to show such video streams. (See Marnell Col. 3. Lines 23-28). This is interpreted as teaching that players can control the cameras (via requests to operators).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to transmit Hagiwara's automated play session to remote players using a video camera, controlled by a player, as taught by Marnell. This yields the predictable results of displaying the automated play game to remote players & would work just as one would expect it to.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo, can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OAD/

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714